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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,202	03/10/2004	Takashi Fujii	TESJ.0068	2428
7590		11/28/2005	EXAMINER	
REED SMITH LLP		CADUGAN, ERICA E		
3110 Fairview Park Drive, Suite 1400		ART UNIT		
Falls Church, VA 22042		PAPER NUMBER		

3722

DATE MAILED: 11/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Tntn

<b>Office Action Summary</b>	<b>Application No.</b> 10/796,202	<b>Applicant(s)</b> FUJII	
	<b>Examiner</b> Erica E. Cadugan	<b>Art Unit</b> 3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered. Specifically, it is noted that the specification on page 1 refers to Japanese Patent Publication No. 6-85951, which has not been cited.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-2 are replete with instances that do not particularly point out and distinctly claim the subject matter of applicant's invention. Examples of these instances are listed below, but these instances are not limited to the listed examples. Applicant is advised to closely review the claims for other occurrences.

It is unclear as set forth in the claims whether they are intended to be method claims, or whether they are instead intended to be apparatus claims. Note that the preamble of claim 1 sets forth a "working system", which would appear to indicate that an apparatus is being claimed, but

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that the body of claim 1 sets forth several limitations setting forth “the step for...”, which would appear to indicate that a method is being claimed. Appropriate correction is required.

There are several instances in the claims where it is unclear, via the use of an indefinite article such as “an” or “a”, whether a limitation is intended to be the same as or different from a previously set forth limitation. For example, claim 1, line 2 sets forth “a metallic wire rod”. However, it is unclear as claimed, via the use of the indefinite article “a”, whether this is intended to be the same as or different from the “metallic wire rod” previously set forth in that claim.

The meaning of the parenthesis in the claims is unclear. Specifically, in the “(bar)” limitation, for example, it is unclear whether the parenthesis are intended to indicate “and”, “or”, “and/or”, or something else entirely. It is further unclear whether or not “(bar)” is even intended to limit the scope of the claims.

In claim 1, step (1), it is unclear as set forth in the claim to what or where the coiled wire rod is “delivered”.

In claim 1, step (3), there is no frame of reference provided for determining what is meant by a “correct” position.

In claim 1, penultimate line, it appears that “if” should be --when--.

In claim 1, last line, “the above tolerances for defects” lacks sufficient antecedent basis in the claim.

In claim 2, line 3, it is unclear whether “a straightening device” is intended to be the same straightening device previously set forth in the claims.

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In claim 2, line 3, it is unclear whether “one or more places” are intended to be the same “one or more places” previously set forth in the claims.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 1, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over JP-3-94914-A ('914) in view of U.S. Pat. No. 4,291,600 to Kawaguchi et al.

'914 teaches a system for working metal wire rod, wherein coiled hot-rolled wire rod 18 is straightened by straightener rolls 28, the quality of the straightened wire is judged at a quality inspection part 32, the inspected wire is cut into desired lengths with a wire cutting machine 34, and the cut wire is sorted according to the results of the quality inspection (i.e., wire is separated based on quality, and thus, the sorted wire that is considered to have undesired quality characteristics based on the quality inspection is considered to have been “rejected” as broadly claimed, when sorted according to quality). See Figure 1 and abstract. As broadly claimed, the results of the quality inspection are inherently considered to have been “stored”, at least in the memory of the person operating the system.

'914 does not appear to explicitly teach what particular features are inspected during the quality inspection, and thus does not teach that the outside diameter and surface defects are judged.

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'600 teaches that surface flaws are inspected (col. 1, lines 17-25 and 29-32, col. 4, lines 32-65, for example), as well as diameter (see column 20, lines 2-4, for example).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have substituted the specific inspections of surface flaws and diameter taught by '600 for the generic inspections taught by '914 for the purpose of providing a well-known means to improve the quality of the finished product.

***Allowable Subject Matter***

6. Claim 2 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Conclusion***

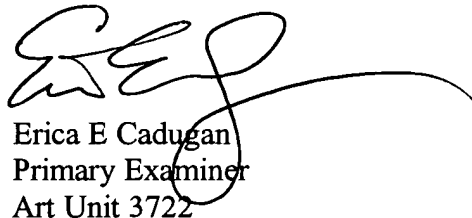
7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erica E. Cadugan whose telephone number is (571) 272-4474. The examiner can normally be reached on M-F, 6:30 a.m. to 4:00 p.m., alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on (571) 272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Erica E Cadugan  
Primary Examiner  
Art Unit 3722

eec  
November 23, 2005